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10/519,272	06/17/2005	Robertus Cornelis Maria Van Rijn	0470-048035	8909
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THE WEBB LAW FIRM, P.C. 700 KOPPERS BUILDING 436 SEVENTH AVENUE PITTSBURGH, PA 15219			EXAMINER	
			BUTLER, PATRICK NEAL	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/519,272	<b>Applicant(s)</b> VAN RIJN, ROBERTUS CORNELIS MARIA
	<b>Examiner</b> Patrick Butler	<b>Art Unit</b> 1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 August 2005.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 20-35 is/are pending in the application.
  - 4a) Of the above claim(s), \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 20-35 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 20050804
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22, 23, 27, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 22, the term "thread-like" renders the claim indefinite because the addition of the word "like" to an otherwise definite expression extends the scope of the expression so as to render it indefinite (MPEP 2173.05 (b)(E)). For purposes of examination, the Examiner assumes the term "threaded".

Regarding Claim 23, the term "boyonet-like" renders the claim indefinite because the addition of the word "like" to an otherwise definite expression extends the scope of the expression so as to render it indefinite (MPEP 2173.05 (b)(E)). For purposes of examination, the Examiner assumes the term "bayonet recess".

With respect to Claim 27, the parenthetical term "adjustment" renders the claim indefinite because it is unclear whether the parenthetical limitations the phrase are part of the claimed invention. For purposes of examination, the Examiner assumes that a bolt is required to meet the limitations of the claim. Claim 28 is rejected via its dependency.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 20 and 34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 25, 28, and 29 of copending Application No. 10/519,273.

With respect to Claim 20, Claim 25 of copending Application No. 10/519,273 teaches providing a concrete part having a cavity which extends from an outer wall thereof (a method for arranging engagement means in a concrete part; arranging said body at the formwork surface) placing an elastomers material body into a framework (providing a body whose exterior comprises an elastomeric material; providing a formwork; comprises a supporting surface; self-supporting; secured to said formwork) where the elastomeric material body can be removed from the concrete by being elastically reduced (with mechanical properties such that there is a considerable reduction in the external diameter at removal from the concrete; encasing said body in

concrete material and removing from the concrete after setting), detaching said formwork (removal of the formwork), the cavity accommodating a metal part into the screw thread arranged in said cavity, which necessarily requires a similar shape in the elastomeric body (said body being elongate and is removed from the concrete in its longitudinal direction and is provided with a projection which, at a distance from its end located at the boundary surface of the concrete, is positioned transversely with respect to the longitudinal direction and leaves behind a non-release recess in the concrete after setting, which recess comprises securing means for an engagement part), screwing metal into a screw thread arranged in said cavity (engagement part which is then fitted into the concrete). Claim 29 of copending Application No. 10/519,273 teaches the body comprises a core (wherein said body comprises a core, wherein said core is relatively rigid).

With respect to Claim 34, Claim 28 of copending Application No. 10/519,273 teaches that the part is poured in a factory remote from its final destination (wherein said concrete part is moved to the building site after said recess has been put in place).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20-22, 24, 25, 27, 28, 32, 33, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Mess (US Patent No. 4,074,499).

With respect to Claim 20, Mess teaches making a coil insert or nut member in a concrete panel (a method for arranging engagement means in a concrete part) (see col. 1, lines 12-18) by placing a coil 11 and supporting legs 12 onto a mold bottom 14 with an elastomeric plug 20 inserted into it (providing a body whose exterior comprises an elastomeric material; providing a formwork; ; arranging said body at the formwork surface; comprises a supporting surface; self-supporting; secured to said formwork) (see col. 4, lines 4-12 and 33-60). Concrete is placed around the coil (encasing said body in concrete material and removing from the concrete after setting) (see col. 5, lines 32-42). After the concrete sets, the plug's 20 solid stem 22 is at the plug's 20 radial center and is sufficiently relatively rigid to be grasped by pliers and used to remove the plug 20 while the plug collapses (removing from the concrete after setting; wherein said body comprises a core; wherein said core is relatively rigid; said body being elongate and is removed from the concrete in its longitudinal direction) (see col. 4, lines 33-50; col. 5, lines 40-50; and fig. 6). The plug collapses radially (with mechanical properties such that there is a considerable reduction in the external diameter at removal from the concrete; encasing said body in concrete material and removing from the concrete after setting) (see col. 5, lines 40-50). A bolt 15 is inserted (engagement part which is then fitted into the concrete) (see col. 4, lines 13-33), and the concrete slab is hoisted away from its mold (removal of the formwork) (see col. 4, lines 13-33). The plug 20 is molded with internal threads (is provided with a projection which, at a distance from its end

located at the boundary surface of the concrete, is position transversely with respect to the longitudinal direction and leaves behind a non-release recess in the concrete after setting, which recess comprises securing means for an engagement part) (see col. 4, lines 33-50).

With respect to Claims 21, 22, and 33, Mess teaches that the plug 20 is molded with internal threads and secured against a coil having the opposite shape to accommodate a threaded bolt (projection comprises a continuous surface designed in such a manner that it is able to absorb both tensile and compressive forces; securing means comprise a screw recess in the concrete material and the engagement part is designed accordingly; securing means comprise a metal part which absorbs tensile and/or compressive forces and extends over the entire extent of the concrete part in the transverse direction) (see col. 4, lines 4-50).

With respect to Claims 24 and 27, Mess teaches that a hole is formed on the slab accommodates a bolt after its construction (in which said securing means are arranged on/in front of the said body, which securing means remain in the recess when said body is removed; engagement part comprises a bolt) (see col. 1, lines 33-43).

With respect to Claim 25, Mess teaches that the bolt 15 inserted into the concrete slab attached to lift pick-up means 17, which attaches to a hoisting cable (wherein the said engagement part comprises a hoisting means) (see col. 4, lines 13-33).

With respect to Claim 28, Mess teaches that the concrete hole is filled after use to disguise the hole, which would necessarily form a concrete bolt with the hole (bolt comprises concrete material) (see col. 1, lines 33-43).

With respect to Claim 32, Mess teaches incorporating several coil inserts into the slab (wherein a series of engagement surfaces is arranged in a concrete part, which extends from an outer wall thereof, comprises the steps of, placing a series of bodies into said formwork, wherein each cavity comprises a blind bore) (see col. 5, lines 32-50 and fig. 1).

With respect to Claim 35, Mess teaches that after the concrete sets, the plug's 20 solid stem 22 is at the plug's 20 radial center and is sufficiently relatively rigid to be grasped by pliers and used to remove the plug 20 while the plug collapses, which could alternatively be grasped and removed by hand (wherein said body can be removed by hand) (see col. 4, lines 33-50; col. 5, lines 40-50; and fig. 6).

Claims 20, 24, 29-32, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by S.T.U.P. (Belgium Patent No. 502,991, translation relied upon for text citation).

With respect to Claim 20, S.T.U.P. teaches creating a cavity with truncated cone sections in concrete (a method for arranging engagement means in a concrete part) (see page 11, second full paragraph and fig. 16). S.T.U.P. teaches placing a core 1 and shaping rod 3 inside within a mold 8, 9, 10 (providing a formwork; arranging said body at the formwork surface) (see page 9, first full paragraph and fig. 13) with the core 1 made of rubber (providing a body whose exterior comprises an elastomeric material)

(see paragraph bridging pages 4 and 5). The shaping rod 3 is steel and is held in place in the mold with the rod (wherein said body comprises a core; wherein said core is relatively rigid; comprises a supporting surface; self-supporting; secured to said formwork) (see fig. 13). Concrete is poured and cured around the core 1 (encasing said body in concrete material and removing from the concrete after setting) (see page 1, first full paragraph), and the shaping rod 3 and core 1 are pulled out (removing from the concrete after setting) (see paragraph bridging pages 3 and 4), with the shaping rod 3 reducing its transverse cross section (said body being elongate and is removed from the concrete in its longitudinal direction; with mechanical properties such that there is a considerable reduction in the external diameter at removal from the concrete; encasing said body in concrete material and removing from the concrete after setting) (see page 3, first full paragraph). The mold is taken apart (removal of the formwork) (see paragraph bridging pages 9 and 10) and cables 14 are then inserted (engagement part which is then fitted into the concrete) (see paragraph bridging pages 9 and 10 and page 10, first full paragraph). The cavity is formed with truncated cone sections (is provided with a projection which, at a distance from its end located at the boundary surface of the concrete, is positioned transversely with respect to the longitudinal direction and leaves behind a non-release recess in the concrete after setting, which recess comprises securing means for an engagement part) (see page 11, second full paragraph and fig. 16).

With respect to Claim 24, S.T.U.P. teaches that the cavity is formed with truncated cone sections (securing means are arranged on/in front of the said body,

which securing means remain in the recess when said body is removed) (see page 11, second full paragraph and fig. 16).

With respect to Claim 29, S.T.U.P. teaches using a core 1 with sufficient internal room to contract around an internal shaping rod 3 (said core, because of its shape and configuration gives space to the wall thereof) (see paragraph bridging pages 3 and 4).

With respect to Claim 30, S.T.U.P. teaches removing the internal shaping rod 3 before the core 1 (core is separated from the elastomeric material when the body is removed from the concrete) (see paragraph bridging pages 3 and 4).

With respect to Claim 31, S.T.U.P. teaches supporting a series of cores 1 with a mold (providing a series of bodies which are secured to a common carrier) (see page 8, second full paragraph and fig. 11).

With respect to Claim 32, S.T.U.P. teaches supporting a series of cores 1 with a mold and forming blind bores (a series of engagement surfaces is arranged in a concrete part which extend from an outer wall thereof, comprising the steps of placing a series of bodies into the formwork, wherein each cavity comprising a blind bore) (see page 8, second full paragraph and figs. 11 and 16).

With respect to Claim 35, S.T.U.P. teaches that the cores may be pulled from the concrete (see paragraph bridging pages 3 and 4), which could be done by hand.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over S.T.U.P. (Belgium Patent No. 502,991, translation relied upon for text citation) as applied Claim 20 above and further in view of Tye (US Patent No. 4,018,470).

With respect to Claim 23, S.T.U.P. teaches that the cavity is formed with truncated cone sections (see page 11, second full paragraph and fig. 16) as previously described. However, S.T.U.P. does not appear to expressly teach that the securing means is a bayonet recess. Tye teaches making the anchor to a slab interact with a pick-up insert 12 that allows the T-head insert to engage internal thrust surfaces 38 (see col. 8, line 45 through col. 9, line 11), which is at least two bayonet connections. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Tye's anchor shape as the cavity shape in S.T.U.P. because the lock is a well-known anchor for lifting concrete slabs and because the lock transfers the vertical load without bending or twisting and causing resultant failure (see col. 1, lines 61 through col. 2, line 43).

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mess (US Patent No. 4,074,499) as applied to Claim 25 above and further in view of S.T.U.P. (Belgium Patent No. 502,991, translation relied upon for text citation).

With respect to Claim 26, Mess teaches that the bolt 15 inserted into the concrete slab attached to lift pick-up means 17, which attaches to a hoisting cable (wherein the said engagement part comprises a hoisting means) (see col. 4, lines 13-33) as described above. However, Mess does not appear to expressly teach that the

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cavity is open at both ends at the same boundary surface of the concrete part and is U-shaped. S.T.U.P. teaches forming a U-shaped cavity (see page 6, last paragraph and fig. 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use S.T.U.P.'s U-shaped rod as shape of the plug and coil in the process of making a concrete slab with an opening as taught by Mess in order to provide a curved cavity (see S.T.U.P., paragraph bridging pages 7 and 8).

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mess (US Patent No. 4,074,499) as applied Claim 27 above and further in view of Krauss (German Patent No. DE 43 24 522 C1, machine translation relied upon for text citation).

With respect to Claim 28, Mess teaches a method of making a coil insert or nut member in a concrete panel (see col. 1, lines 12-18) in which a bolt 15 is inserted (see col. 4, lines 13-33) as previously described. If it is held that Mess's filling of the hole (see col. 1, lines 33-43) does not constitute a teaching of a bolt comprising concrete material then Mess does not appear to expressly teach said limitation. Krauss teaches adding concrete 6 around a reinforcing bar 5 in a block's central passage 4 (see page 3, second full paragraph and fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Krauss's concrete around reinforcing bar in concrete holes of Mess in order to simplify forming large elements (see page 1, paragraphs 3-5).

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mess (US Patent No. 4,074,499) as applied Claim 20 above and further in view of Reay (US Patent No. 5,660,020).

With respect to Claim 34, Mess teaches a method of making a coil insert or nut member in a concrete panel (see col. 1, lines 12-18) in which a bolt 15 is inserted (see col. 4, lines 13-33) as previously described. However, Mess does not appear to expressly teach that the concrete part is moved to the building site after said recess has been put in place. Reay teach that a building panel may be made on or off site (see col. 2, lines 10-23). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a panel off site as taught by Reay in the process of making a panel as taught by Mess in order to centralize construction and process control.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over S.T.U.P. (Belgium Patent No. 502,991, translation relied upon for text citation) as applied Claim 20 above and further in view of Reay (US Patent No. 5,660,020).

With respect to Claim 34, S.T.U.P. teaches creating a cavity in concrete as previously described. However, S.T.U.P. does not appear to expressly teach that the concrete part is moved to the building site after said recess has been put in place. Reay teach that a building panel may be made on or off site (see col. 2, lines 10-23). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a panel off site as taught by Reay in the process of making a panel as taught by S.T.U.P. in order to centralize construction and process control.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Butler whose telephone number is (571) 272-

8517. The examiner can normally be reached on Mon.-Thu. 7:30 a.m.-5 p.m. and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. B./  
Examiner, Art Unit 1791

/Monica A Huson/  
Primary Examiner, Art Unit 1791